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Patent



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: WILCE et al.

Application Serial No.: 09/939,911

Filing Date: August 27, 2001

For: SYSTEMS AND METHODS FOR
FACILITATING USE OF
AGREEMENT INFORMATION VIA
AN AGREEMENT MODELING
SYSTEM

) Group Art Unit: 3628

) Examiner: Jennifer Liversedge

) **RESPONSE TRANSMITTAL to**
) **Notification of Non-Compliant Appeal**
) **Brief (37 CFR 41.37) mailed 07/17/2006**

) Attorney Docket No.: G08.003

) **PTO Customer Number 28062**
) Buckley, Maschoff & Talwalkar LLC
) Five Elm Street
) New Canaan, CT 06840

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 17, 2006.

Dated: August 17, 2006

By:


Edith Martin

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

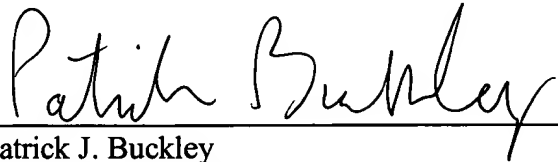
Transmitted herewith for filing are:

1. ☒ Resubmitted Appeal Brief (re-submission of second Appeal Brief filed herein)
2. ☒ Appendix A – Claims
3. ☒ Appendix B – Evidence
4. ☒ Appendix C – Related Proceedings
5. ☒ Additional Enclosures: Acknowledgement Postcard

The Commissioner is hereby authorized to charge and credit Deposit Account No. 50-1852 as described below. A duplicate copy of this sheet is enclosed.

- ☒ Credit any overpayment.
- ☒ Charge any additional fees required under 37 CFR 1.17.

Respectfully submitted,



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August 17, 2006
Date



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) **RE-SUBMITTED APPEAL BRIEF (re-**
) **submission of second Appeal Brief filed**
) **herein) in Response to Notification of**
) **Non-Compliant Appeal Brief (37 CFR**
) **41.37) mailed 07/17/2006**

) Attorney Docket No.: G08.003

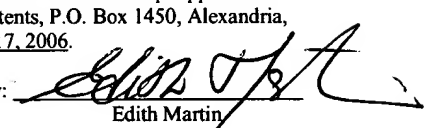
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Dated: August 17, 2006

By:


Edith Martin

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Notification of Non-Compliant Appeal Brief mailed July 17, 2006, Appellants hereby resubmit an appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed November 22, 2005 (the "Final Office Action") rejecting claims 17-23 and 41-55.

REAL PARTY IN INTEREST

The present application is assigned to GOLDMAN, SACHS & CO., 85 Broad Street, New York, New York 10004, U.S.A.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellants or Appellants' legal representative which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. The present application has not been assigned to any other party.

STATUS OF CLAIMS

Claims 1-16 and 24-40 have been canceled.

Claims 17-23 and 41-55 stand rejected and are being appealed.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Final Office Action.

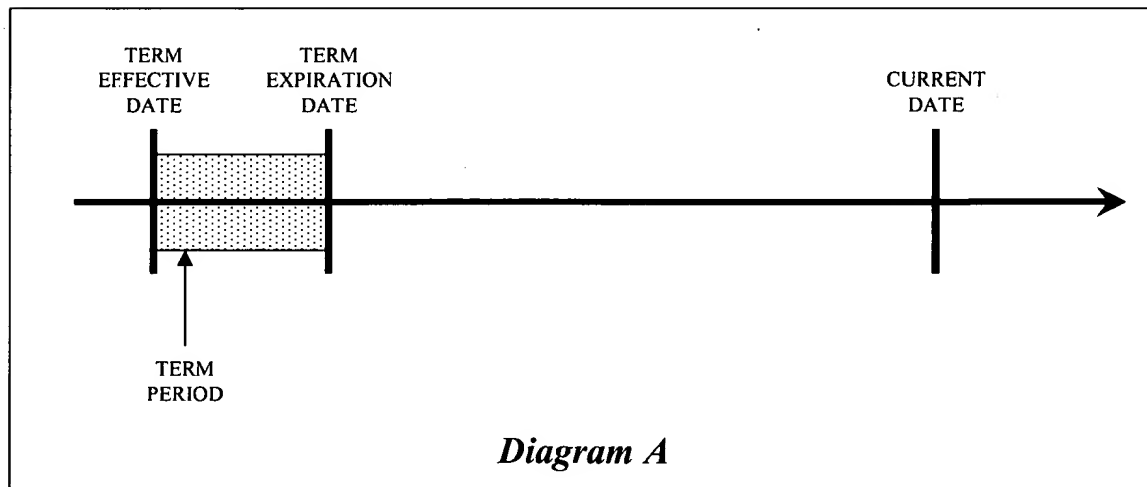
SUMMARY OF THE CLAIMED SUBJECT MATTER

An agreement between a party and a counter-party may include a number of agreement terms. For example, a contract between two parties may indicate a set of financial instruments that can be exchanged between the parties. *See, e.g.*, Specification at page 20, lines 3 to 12. Such terms may be effective over a pre-defined period of time (*e.g.*, from January 1, 2003 to December 31, 2003). Moreover, such terms might be modified by the parties (*e.g.*, a new

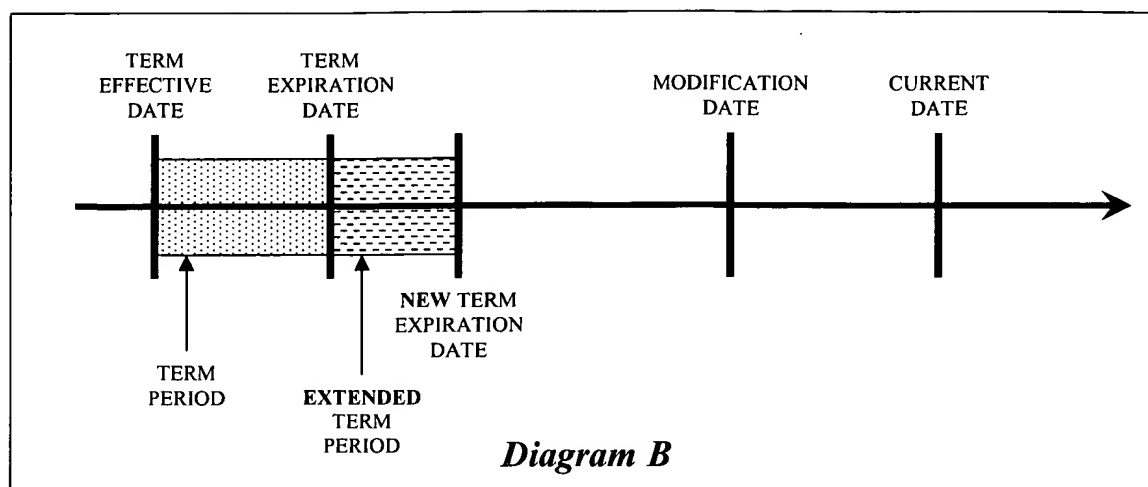
financial instrument might be added to the set that is covered by an agreement term), and, in some cases, a modification might be retroactive (*e.g.*, a transaction that was not covered by a term when it was executed might now be covered). *See, e.g.*, Specification at page 26, lines 20 to 25 and page 29, lines 27 to 28. Determining the status of an agreement as of a particular date (*e.g.*, the end of last quarter) via a manual review of an existing agreement documents (*e.g.*, a master contract and a number of contract amendments) can be a time-consuming and error prone process. *See, e.g.*, Specification at page 1, lines 13 to 20.

According to some embodiments of the present invention, an automated system is provided to “determin[e] an applicability of the agreement term with respect to the transaction, as of the query date, based at least in part on a comparison of the term date, the transaction date, the modification date, and the query date” (a limitation generally recited in each of the pending independent claims, as amended, and described in the Specification, for example at page 28, line 22 to page 30, line 6).

Exemplary diagrams will now be provided, including *Diagram A* which shows a time-line in accordance with some embodiments. *See, e.g.*, FIGS. 13 and 14 as originally filed.

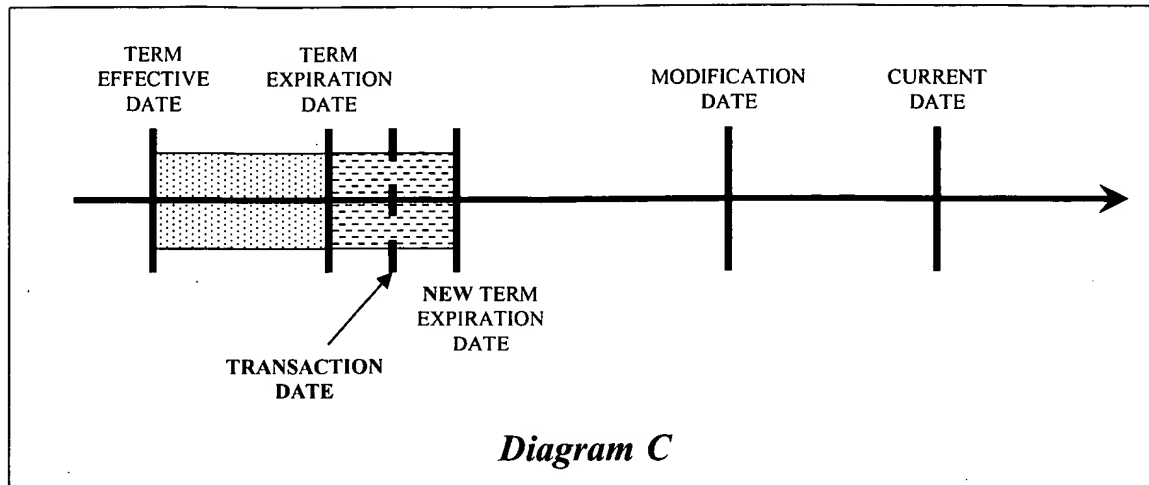


The timeline shown in *Diagram A* might be associated with, for example, an agreement such as a contract and/or financial instrument agreement. A term of the agreement (*e.g.*, “TERM”), such as a clause or other term, may be effective starting on a “TERM EFFECTIVE DATE” and may expire upon a “TERM EXPIRATION DATE”. In other words, the TERM may be effective over a “TERM PERIOD”, as shown. Consider now a retroactive modification (*e.g.*, “MODIFICATION”) to the agreement is made on a “MODIFICATION DATE”, as shown in *Diagram B*.



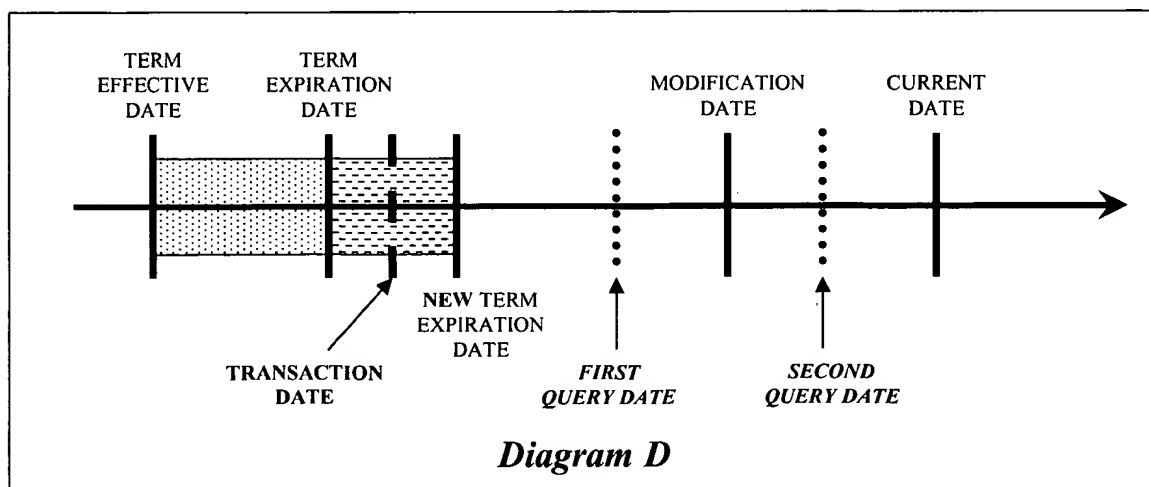
The MODIFICATION may, for example, be an alteration of the agreement approved by both parties for various reasons (e.g., due to financial instrument changes, renegotiations, and/or other reasons that are typical or possible with respect to agreements made in various industries). As shown in *Diagram B*, the MODIFICATION may retroactively modify the TERM EXPIRATION DATE that ends the applicability of the agreement TERM. In other words, the TERM EXPIRATION DATE is moved to a **NEW TERM EXPIRATION DATE**, defining a new and **EXTENDED TERM PERIOD**, as shown. The MODIFICATION may cause complications, in typical systems however, when a user attempts to retrieve information regarding the agreement. See, e.g., FIGS. 13 and 14 as originally filed and Specification at page 28, line 2 to page 29, line 6.

For example, as shown in *Diagram C*, the user may query, in typical systems, to determine if a TRANSACTION, occurring on a “**TRANSACTION DATE**” (occurring as shown) is covered by the agreement. In typical systems, however, any query submitted after the MODIFICATION DATE (e.g., on the CURRENT DATE) will show that the MODIFICATION applies, and that the TRANSACTION is covered by the agreement. Such results may not, however, be desirable. In the case that the user desires to query the applicability of the TERM to the TRANSACTION *as viewed from a different date* than the CURRENT DATE (e.g., the end of last quarter) prior systems are simply incapable of providing such query results.



As shown in Diagram D, for example, currently claimed embodiments provide *determining an applicability of the agreement term with respect to the transaction, as of the query date, based at least in part on a comparison of the term date, the transaction date, the modification date, and the query date.* Moreover, currently claimed embodiments let the user enter a “QUERY DATE” different than the CURRENT DATE. *See, e.g., Specification at page 30, lines 4 to 6.* This gives the user great flexibility in querying agreement information and lets the user determine the applicability of the TERM to the TRANSACTION *as viewed from the perspective of a specific QUERY DATE (different than the CURRENT DATE).*

As shown in *Diagram D*, for example, the user may submit the **FIRST and/or SECOND QUERY DATE**. The user may discover that as of the **FIRST QUERY DATE**, the TERM *did not apply* to the TRANSACTION, yet as of the **SECOND QUERY DATE** (after the MODIFICATION DATE), the TERM *did apply* to the TRANSACTION. *See FIGS. 13-14 and Specification page 28, line 22 to page 30, line 6.*



In other words, the agreement modeling system of currently claimed embodiments may compare the TERM DATE, the TRANSACTION DATE, the MODIFICATION DATE, and the QUERY date to determine the applicability of the TERM to the TRANSACTION as of the user's QUERY DATE. *See, e.g.*, FIG. 12 as originally filed and Specification at page 28, lines 1 to 21.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 17-23, 41-44 and 46-55 stand rejected under 35 USC 103 as being unpatentable over US Publication No. 2002/0010686 (“Whitesage”) in view of US Publication No. 2003/0172006 (“Fino”) and further in view of “RB&W Negotiating Agreements to Cure a Default” by R.C. Drabik, Business Wire, January 30, 1992 (“Drabik”).

Claim 45 stands rejected under 35 USC 103 as being unpatentable over Whitesage in view of Fino and further in view of US Patent No. 5,826,244 (“Huberman”).

ARGUMENT

Claims 17-23, 41-44 and 46-55 stand rejected under 35 USC 103 as being unpatentable over US Publication No. 2002/0010686 (“Whitesage”) in view of US Publication No. 2003/0172006 (“Fino”) and further in view of “RB&W Negotiating Agreements to Cure a Default” by R.C. Drabik, Business Wire, January 30, 1992 (“Drabik”)

None of the cited references disclose “determining ... an applicability of the agreement term with respect to the transaction, as of the query date, based at least in part on a comparison of the term date, the transaction date, the modification date, and the query date” as recited in claim 17.

According to the Office Action, Fino discloses such a feature in FIGS. 5F, 5H and/or 5J (Final Office Action, bottom of page 3 to top of page 4 and top of page 13).

Appellants respectfully disagree. Nothing in these figures suggest that an applicability of an agreement term is determined based on a query date based on a transaction date, modification

date, and a query date. The FIGS. merely indicate that building options, each associated with a date the option was requested or agreed to, can be displayed to a user.

Neither Whitesage nor Fino teach, suggest, or even mention **a query date that is different than the current date**, much less utilizing such a query date in a determination of whether or not an agreement term applied to a transaction **as of the query date**.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531,1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), although “the suggestion more often comes from the teachings of the pertinent references,” In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir.1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R.Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir.1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not evidence. Thus, when an Examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

The entire discussion in Final Office as to why it would have been obvious to modify the system of Whitesage using the teachings of Fino is reproduced here for convenience:

to provide the user more options to
view the status of the contract

(Final Office Action, middle of page 4). Appellants respectfully do not understand this reasoning. While the present invention does provide this benefit, there is no convincing argument that would lead to the conclusion that one of ordinary skill in the art would have been motivated to modify either reference in the ways suggested by the Examiner.

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The fact that references can potentially be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (the question to be asked is "whether the prior art contains a suggestion or motivation to combine references").

The absence of any motivation in the prior art (and the lack of a convincing line of reasoning) to modify the references in the ways recited in the pending claims indicates that the Examiner has simply recognized a benefit provided by the present invention, and then used that benefit as a motivation to combine the references – the essence of impermissible hindsight reconstruction.

Because there is no teaching or suggestion to modify the references in this way, a *prima facie* case of obviousness has not been established. The rejection of these claims should be reversed.

Similarly, the entire discussion in Final Office as to why it would have been obvious to modify the system of Whitesage/Fino using the teachings of Drabik is reproduced here for convenience:

at times, either the supplier or the customer would require some type of modification to the contract and a method for capturing and implementing those changes would be required

(Final Office Action, bottom of page 4 to top of page 5). Again, there is no convincing line of reasoning that would lead to the conclusion that one of ordinary skill in the art would have been motivated to modify either reference to produce a system as recited in the pending claims.

Moreover, nothing in the Examiner's discussion of the "Internet Wayback Machine" at page 13 of the Final Office Action¹ provides a motivation to modify any of the references in ways that would produce a system as recited in the pending claims.

Claim 45 stands rejected under 35 USC 103 as being unpatentable over Whitesage in view of Fino and further in view of US Patent No. 5,826,244 ("Huberman")

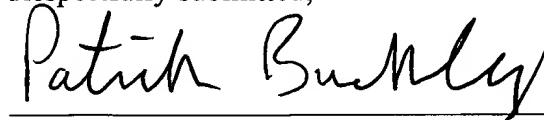
Claim 45 depends from claim 17 and should therefore be allowable in view of the above comments set forth with respect to claim 17.

CONCLUSION

Appellants respectfully suggest that rejections of claims 17-23 and 41-55 are improper and request that the rejections be reversed. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned.

August 17, 2006
Date

Respectfully submitted,



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New Canaan, CT 06840

Appendix A - Claims
Appendix B - Evidence
Appendix C - Related Proceedings

¹ To the extent the Examiner is relying on Official Notice and/or the Wayback Machine to support rejections of the pending claims, Appellants respectfully object and request that a reference be provided.

APPENDIX A - CLAIMS

This is a complete copy of the claims involved in the appeal:

17. A method for utilizing an agreement modeling system, comprising:

receiving, by an agreement modeling system, an indication of an agreement between a party and a counter-party, the agreement including an agreement term associated with a term date;

receiving, by the agreement modeling system, subsequent to the receiving of the indication of the agreement, an indication of a retroactive modification to the agreement, wherein the retroactive modification to the agreement is associated with a modification date;

storing, by the agreement modeling system, information indicative of the agreement term, information indicative of the term date, information indicative of the retroactive modification, and information indicative of the modification date;

receiving, by the agreement modeling system, a query, wherein the query comprises an indication of a query date, the query date being a date other than the date on which the indication of the query date is received, and an indication of a transaction date associated with a transaction, wherein the transaction date is different than the query date;

determining, by the agreement modeling system, an applicability of the agreement term with respect to the transaction, as of the query date, based at least in part on a comparison of the term date, the transaction date, the modification date, and the query date; and

providing, by the agreement modeling system, an indication of the determination.

18. The method of claim 17, wherein the term date comprises at least one of: (i) a term effective date, (ii) a term expiration date, (iii) a term period, or (iv) a term entry date.

19. The method of claim 17, wherein the query date comprises a date indicated by a user.

20. The method of claim 17, wherein the indication of the agreement comprises at least one of: (i) an agreement identifier, (ii) a document identifier, (iii) a party entity identifier, (iv) a counter-party identifier, (v) a financial instrument identifier, or (vi) a financial product identifier.

21. The method of claim 17, wherein at least one of the receiving of the indication of the agreement, the receiving of the indication of the retroactive modification of the agreement, or the receiving of the query comprises receiving information from at least one of: (i) a user, or (ii) a satellite system.

22. The method of claim 17, wherein the providing comprises:

transmitting an indication of the determination of the applicability of the agreement term with respect to the transaction, as of the query date, to at least one of: (i) a user, or (ii) a satellite system.

23. The method of claim 22, further comprising:

transmitting an indication associated with a supporting agreement document.

41. The method of claim 17, further comprising:

receiving, by the agreement modeling system, transaction information associated with the transaction and the agreement;

identifying, by the agreement modeling system, agreement information associated with the agreement, wherein the agreement information is stored by the agreement modeling system;

evaluating, by the agreement modeling system, the transaction information and the agreement information; and

generating, by the agreement modeling system, an indication based on said evaluating.

42. The method of claim 41, wherein said receiving of the transaction information comprises receiving the transaction information from at least one of: (i) a user, or (ii) a satellite system.

43. The method of claim 42, wherein the satellite system comprises at least one of: (i) a business system, (ii) a legal system, (iii) a compliance system, (iv) a credit system, (v) a treasury system, or (vi) an operations system.

44. The method of claim 41, wherein the transaction information is associated with at least one of: (i) a party entity, (ii) a counter-party, (iii) the transaction date, (iv) an agreement date, (v) a financial product, (vi) a financial instrument, or (vii) a monetary amount.

45. The method of claim 44, wherein the financial product comprises at least one of: (i) an equity product, (ii) a stock product, (iii) an index product, (iv) a fixed income product, (v) a bond product, (vi) a bank loan product, (vii) a whole loan product, (viii) an interest rate product, (ix) a credit derivative product, (x) a commodity product, (xi) a metal product, (xii) a energy product, or (xiii) an agriculture product.

46. The method of claim 44, wherein the financial instrument comprises at least one of: (i) a swap instrument, (ii) an option instrument, (iii) a buy instrument, (iv) a sell instrument, (v) a call instrument, (vi) a put instrument, (vii) a forward instrument, (viii) a pre-paid forward instrument, (ix) a spot instrument, (x) a repurchase agreement instrument, (xi) a loan instrument, (xii) a warrant instrument, or (xiii) a contract for differences instrument.

47. The method of claim 41, wherein the agreement information is associated with a covered products matrix.

48. The method of claim 41, wherein the indication comprises at least one of: (i) an indication of approval, (ii) an indication of non-approval, (iii) an indication that further evaluation is required, or (iv) an indication that an amendment to an agreement is required.

49. The method of claim 41, wherein said generating comprises transmitting the indication to at least one of: (i) a user, or (ii) a satellite system.

50. The method of claim 41, wherein the transaction comprises at least one of: (i) a pending transaction, or (ii) a completed transaction.

51. The method of claim 41, wherein said evaluating is performed on at least one of: (i) a transaction basis, or (ii) a batch of transactions.

52. An apparatus for utilizing an agreement modeling system, comprising:
a processor; and
a storage device in communication with said processor and storing instructions adapted to be executed by said processor to:

receive an indication of an agreement between a party and a counter-party, the agreement including an agreement term associated with a term date;

receive, subsequent to the receiving of the indication of the agreement, an indication of a retroactive modification to the agreement, wherein the retroactive modification to the agreement is associated with a modification date;

store at least one of information indicative of the agreement term, information indicative of the term date, information indicative of the retroactive modification, or information indicative of the modification date;

receive a query, wherein the query comprises an indication of a query date, the query date being a date other than the date on which the indication of the query date is

received, and an indication of a transaction date associated with a transaction, wherein the transaction date is different than the query date;

determine an applicability of the agreement term with respect to the transaction, as of the query date, based at least in part on a comparison of the term date, the transaction date, the modification date, and the query date; and

provide the determination of the applicability of the agreement term with respect to the transaction, as of the query date.

53. The apparatus of claim 52, wherein said storage device further stores an agreement information database.

54. The apparatus of claim 52, further comprising:

a communication device coupled to said processor and adapted to communicate with at least one of: (i) a client device, (ii) an agreement modeling system controller, (iii) a satellite system, or (iv) a counter-party device.

55. A medium storing instructions adapted to be executed by a processor to perform a method of utilizing an agreement modeling system, said method comprising:

receiving, by an agreement modeling system, an indication of an agreement between a party and a counter-party, the agreement including an agreement term associated with a term date;

receiving by the agreement modeling system, subsequent to the receiving of the indication of the agreement, an indication of a retroactive modification to the agreement, wherein the retroactive modification to the agreement is associated with a modification date;

storing, by the agreement modeling system, at least one of information indicative of the agreement term, information indicative of the term date, information indicative of the retroactive modification, or information indicative of the modification date;

receiving, by the agreement modeling system, a query, wherein the query comprises an indication of a query date, the query date being a date other than the date on which the indication of the query date is received, and an indication of a transaction date associated with a transaction, wherein the transaction date is different than the query date;

determining, by the agreement modeling system, an applicability of the agreement term with respect to the transaction, as of the query date, based at least in part on a comparison of the term date, the transaction date, the modification date, and the query date; and

providing, by the agreement modeling system, the determination of the applicability of the agreement term with respect to the transaction, as of the query date.

APPENDIX B - EVIDENCE

No evidence is submitted herewith (*i.e.*, this appendix is empty).

APPENDIX C - RELATED PROCEEDINGS

No other appeals or interferences are known to Applicants or Applicants' legal representative which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. The present application has not been assigned to any other party.

Therefore, there are no copies of decisions rendered by a court or the Board to attach (*i.e.*, this appendix is empty).